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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,284	07/10/2003	Goro Kawasaki	1109.68152	2558

7590 11/05/2008  
Patrick G. Burns, Esq.  
Greer, Burns & Crain, Ltd.  
Suite 2500  
300 South Wacker Drive  
Chicago, IL 60606

EXAMINER
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KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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11/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/617,284	<b>Applicant(s)</b> KAWASAKI ET AL.	
	<b>Examiner</b> William J. Klimowicz	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/794,369.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-10-03</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restrictions***

***Rejoinder of Inventions***

The Applicant's election of the Invention of Group I, claims 1-12 and 17, as well as Species I, in the Response filed on September 8, 2008, is noted.

Claims 1-12 and 17 are being rejected for double patenting, *infra*. Upon filing a proper Terminal Disclaimer with appropriate fee, claims 1-12 would be allowable. The restriction requirement mailed July 28, 2008, has been reconsidered in view of the potential allowability of claims to the elected invention pursuant to MPEP § 821.04(a). More concretely, after a search for prior art was conducted, in conjunction with a comparison between the nonelected invention and the elected invention, it has been determined *a posteriori* examination, that the claims between the previously elected groups are not patentably distinguishable. Thus, claims 4-6, 11 and 12 have been rejoined, examined on the merits, in addition to matters of form, including **Title 35** to the **United States Code**, sections **101**, **102**, **103** and **112**, to each previously grouped invention, and allowed, *in toto*.

**The restriction requirement pertaining to the Species restriction only, is hereby withdrawn.** Claims 4-6, 11 and 12 are no longer withdrawn from consideration.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 13-16 are currently withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 8, 2008.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A patent to a genus would, necessarily, extend the rights of a species or sub-species should the genus claims of the instant application issue after the after the species or subgenus. Therefore, in this type of obvious-type double patenting situation, a Graham analysis of the type required in an Obviousness-Type Double Patenting situation is not required, albeit certainly, one could readily be applied.

Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent Number 6,618,330 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is broader in every aspect than claims 1-12 of U.S. Patent Number 6,618,330 B1.

Claims 1-12 of U.S. Patent Number 6,618,330 B1 are identical in every aspect with respect to claims 1-12 of the instant application, except that claim 1 of the instant application includes a generic description of a slider (lens support, in lieu of a slider).

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Moreover still, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 1-12 of the instant application are generic to all that is recited in claims 1-12 of U.S. Patent Number 6,618,330 B1. That is, claims 1-12 of the instant application are anticipated by claims 1-12 of U.S. Patent Number 6,618,330 B1. Additionally, see *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d, 1869 and *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894).

Claim 17 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of prior U.S. Patent Number 6,618,330 B1. This is a double patenting rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Friday (7:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William J. Klimowicz/  
Primary Examiner, Art Unit 2627